



**PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Keiko SHIRAISHI et al.

Group Art Unit: 2178

Application No.: 10/662,337

Examiner: M. PATEL

Filed: September 16, 2003

Docket No.: 117194

For: INSTRUCTION FORM RETRIEVAL APPARATUS, INSTRUCTION FORM  
EXECUTION APPARATUS, INSTRUCTION FORM MANAGEMENT SYSTEM  
AND INSTRUCTION FORM RETRIEVAL METHOD

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This request is being filed with a Notice of Appeal. Review of the February 5, 2009 Final Rejection is requested for the reasons set forth in the attached five or fewer sheets. No Amendments are being filed with this request. The claims on appeal are claims 1-17.

The Office Action rejects claims 1-17 under 35 U.S.C. §102(a) over European Patent Publication No. EP 1 286 254 to Ito<sup>1</sup>.

Regarding independent claims 1, 10-13 and 16-17, Ito fails to disclose:

(1) "the at least one instruction form includes instructions indicating a plurality of processing to be executed by a plurality of instruction form execution apparatus" (emphasis added; claims 1, 11 and 16-17, and similarly recited in claims 10 and 12);

(2) "at least one instruction form associated with a [or "the"] user" (emphasis and comment added, claims 1, 10-13 and 16-17) and "wherein ... the at least one instruction form is associated with the user information" (emphasis added; claim 1 and similarly recited in claims 10, 13 and 16);

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<sup>1</sup> The Office Action identifies the applied reference as Tetsuo, the inventor's first name. The inventor's surname, Ito, is used herein.

(3) "a reception part that receives information on a [or "the"] user" (emphasis and comment added; claims 1 and 10, and similarly recited in claim 13);

(4) "a retrieval part that retrieves one of the at least one instruction form accessible to the user from the instruction form management apparatus based on the received information on the user" (emphasis added; claims 1 and 10 and similarly recited in claims 13 and 16);

(5) "an output part that outputs identification information on the retrieved instruction form to allow the user to select a process from the plurality of processing indicated in the retrieved instruction form and instruct one or more of the plurality of instruction form execution apparatuses connected to the instruction form retrieval apparatus via the network to carry out the selected process" (emphasis added, claims 1, 10, and similarly recited in claim 13);

(6) "a storage part that stores user information" (emphasis added; claims 1, 10 and 16, and similarly recited in claim 13);

(7) "a retrieval part that retrieves information on the instruction form management apparatus holding the at least one instruction form accessible to the user based on the information on the user" (emphasis added; claim 16); and

(8) "an attachment part that attaches a portable storage medium capable of being carried by a user that stores at least one selectable instruction form" (emphasis added; claim 17 and similarly recited in claims 11-12).

The Office Action does not cite to any reference characters corresponding to elements in Ito. However, regarding independent claims 1, 10-13 and 16-17, the Office Action cites to Ito at Figs. 1 and 12, and paragraphs [0005]-[0008] as allegedly disclosing an interface allowing users to select predetermined processes; cites to paragraphs [0121]-[0125] (relating to Fig. 12) and paragraphs [0157]-[0170] (relating to Figs. 17-18) as allegedly disclosing a user selectable form in XML language; and cites to Fig. 1 as allegedly disclosing "other hardware resources that are external and connected to the MF-apparatus".

Ito discloses a multifunctional image forming device, MF-apparatus 1200 (Fig. 1), able to interact with a single function image processing device, SF-apparatus 100, over a network. More specifically, Ito discloses that SF-apparatus 100 has a document list screen

G660 (Fig. 11) that enables the user to (a) select an apparatus from a list of apparatuses (Fig. 12, step S94), and (b) select a document from a list of documents (Fig. 12, step S98), after which the document can be processed by the selected apparatus. Paragraphs [0121]-[0125] describe the operation of the flowchart of Fig. 12. A user selects button 651 (Fig. 11; Fig. 12, step S91) to initiate a process. In turn, the SF-apparatus 100 displays a list of apparatus names in the display area 610 in document list screen G660 (Fig. 12, step S93; col. 30, lines 42-44). The user then selects, for example, MF-apparatus 1200 (Fig. 12, step S94; col. 30, lines 45-47). In turn, the SF-apparatus 100 lists the documents that can be processed by the MF-apparatus 1200 in the display area 620 (Fig. 12, step S95; col. 30, line 54 to col. 31, line 3). The user then selects a document to be processed (Fig. 12, step S98; col. 31, lines 3-5). Paragraphs [0157]-[0170] relate to Fig. 17 and disclose a second embodiment different from the embodiment disclosed by paragraphs [0121]-[0125], discussed above, that uses simple object access protocol (SOAP) and extensible markup language (XML) in a web-based version.

Ito fails to disclose feature (1) quoted above because Ito's web interface (document list screen G660) provides a list of apparatus and a list of documents for the user to select from. However, a list of apparatus and a list of documents are not "an instruction form include[ing] instructions indicating a plurality of processing", as claimed. Ito discloses that the user first selects an apparatus and then selects a document to be processed from document list screen G660, but document list screen G660 itself does not contain any instructions indicating a plurality of processing, as claimed.

Ito fails to disclose feature (2) quoted above because Ito does not disclose any instruction form that contains instructions indicating a plurality of processing and does not disclose any instruction form that is associated with a user. The document list screen G660 is not associated with the user, and is not stored in a manner associated with user information, as claimed. In the Response to Arguments section (page 7), the Office Action alleges "the instructions are associated with a user, because they are based on the user selection". However, the claimed feature is that a stored instruction form is associated with a user, not that a user selects a document and an apparatus.

Ito fails to disclose feature (3) quoted above of a reception part that receives information on a user because Ito does not disclose reception of information on a user. In contrast, the user inputs a selection of which apparatus to utilize and which document is to be processed, not information on the user.

Ito fails to disclose feature (4) quoted above of a retrieval part that retrieves an instruction form accessible to the user from the instruction form management apparatus based on the received information on the user because the user selects "document list apparatus" button 1218 (Fig. 1) to have the document list screen G660 displayed (paragraph [0118]). That is, the document list screen G660 is displayed as a result of the user selecting "document list apparatus" button 1218, not based on information on the user, as claimed.

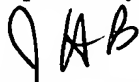
Ito fails to disclose feature (5) quoted above of an output part that outputs identification information on the retrieved instruction form because Ito discloses that the user selects button 651 to display a list of apparatus that can be used to process documents. Once an apparatus is selected, the processing to take place is already determined. Further, the list of apparatus is provided by the SF-appliance 100 but is not derived from any instruction form; thus the claimed output part that outputs identification information on the retrieved instruction form is not taught.

Ito fails to disclose feature (6) quoted above for reasons similar to those stated for feature (3) as discussed above; and Ito fails to disclose feature (7) quoted above for reasons similar to those stated for feature (4) as discussed above.

Ito fails to disclose feature (8) quoted above because Ito does not disclose use of any portable medium. While the Office Action cites to "other hardware resources 1203" (Fig. 1) as corresponding to this feature, Ito does not disclose that this feature includes any removable/portable storage medium. Further, Ito discloses that Fig. 2 shows the hardware of the apparatus of Fig. 1, but Fig. 2 likewise does not show any removable or portable storage device. In the Response to Arguments section (page 7), the Office Action alleges that Ito discloses a USB connection in Fig. 2. However, Ito does not disclose storage of any information file in a portable storage medium in relation to the USB connection.

For the foregoing reasons, the claims are patentable over Ito. Should any questions arise regarding this submission, or the Review Panel believe that anything further would be desirable in order to place this application in even better condition for allowance, the Review Panel is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'JAB', written over the printed name of James A. Oliff.

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